

Paper No.
RFC

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DEC. 21, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re International Data Group, Inc.

Serial Nos. 74/613,181 and 74/613,182

Mark Harrison of Spencer & Frank for International Data
Group, Inc.

Hannah Fisher, Trademark Examining Attorney, Law Office 107
(Thomas Lamone, Managing Attorney).

Before Cissel, Seeherman and Walters, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

This opinion presents our decisions with respect to
the appeals of the refusals to register in the two above-
referenced applications to register the mark "WEB
BUSINESS." Both applications were filed on December 20,
1994, based on the applicant's assertions that it possessed
a bona fide intention to use the mark in commerce. The
goods in the first application, S.N. 74/613,181, are as

follows: "prerecorded videos, audio cassettes, CD-ROMs, and laser discs dealing with products and strategies on the Internet." The second application, as amended, identifies the goods as "magazines, journals, brochures, pamphlets, booklets and manuals dealing with products and strategies on the world wide computer information network."

Each application was refused registration under Section 2(e)(1) of the Act on the ground that the mark sought to be registered is merely descriptive of the goods named in the respective application. In each application, applicant subsequently disclaimed the word "WEB," but maintained that the mark as a whole is not merely descriptive within the meaning of the Lanham Act.

Because the question to be resolved in each of these two appeals is essentially the same, and the records in the respective applications provide the same basis for our resolution of these two cases, we issue this single opinion explaining our rulings in both cases. There are minor distinctions which can be made between these two applications, but they do not alter our conclusion that both refusals are proper.

The basic principles governing the resolution of the issue of whether a mark is merely descriptive of particular products is well settled. A term is merely descriptive

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within the meaning of Section 2(e)(1) of the Act if it immediately and forthwith conveys an idea of a quality, characteristic, function or feature of the goods with which it is used. In re Bright-Crest Ltd., 204 USPQ 591 (TTAB 1979). A term is not merely descriptive of the goods if imagination, speculation or perception is required for one to reach a conclusion as to the nature of the goods based on consideration of the mark and the goods. Manpower Inc. v. Driving Force, Inc., 212 USPQ 961 (TTAB 1981). The determination of descriptiveness must be made by viewing the mark in relation to the goods set forth in the application, considering the context in which the mark is, or will be, used, and by evaluating the significance of the mark to the average purchaser of the goods in question. Roselux Chemical Co. Inc. v. Parsons Amonia Company, Inc., 132 USPQ 627 (CCPA 1962); In re Chicago Pneumatic Tool Company, 160 USPQ 628 (TTAB 1981); and In re Buty-Wave Products, Inc., 198 USPQ 104 (TTAB 1978).

We hold that the term sought to be registered is merely descriptive of the goods set forth in these two applications, namely, "prerecorded videos, audio cassettes, CD-Roms and laser discs dealing with electronic networks," and "magazines, journals, brochures, booklets and manuals dealing with products and strategies on the world wide

computer information network." The words "WEB BUSINESS" immediately convey the fact that the subject matter of the recordings and publications is conducting business on the Web. The term identifies a characteristic or quality of the goods and is therefore unregistrable under Section 2(e)(1) of the Lanham Act.

The evidence made of record by the Examining Attorney supports this conclusion. The best examples are some of the excerpts from the Nexis® database of published articles, which show that "Web business" is commonly used in reference to businesses which operate on the Web, serving users of the world-wide computer network. Typical examples from the first application file are as follows:

'...presentation solutions are essential to the business of any ambitious web business...'; "...if you don't understand this economic reality, you can't run a successful Web business."; "...the Web business is a lot like the PC business..."; "...technology will allow companies to accelerate the transformation of their Web sites to Web businesses..."; "...when it comes to building a successful Web business, creativity is better."; "...in July 1994 formed his new Web business, OnSale."; "...an integrator helping a customer launch a Web business."; and "Providing NetGravity's Adserver technology to CyberCash merchants will help

strengthen existing Web businesses and empower new enterprises on the Web." The following are excerpts from the other application file: "Analysts said Microsoft, like other Web businesses, is still deeply in the red with its Internet efforts."; "...travel-based Web businesses find that consumers are beating a path to their digital door..."; "...a visual Web management tool geared to help Webmasters and Web business managers improve the quality of their Web sites."; "...whether its 160-employee collection of Web businesses will make money..."; "Amazon.com also realized that Web businesses must provide a service as well as sell a product..."; "One start-up Web business even helps people design their own high-performance skis."; "...which profiles women active in Web businesses..."; "...some Web businesses are earning revenue by selling ads on their sites."; "You don't need a lot of capital to start a Web business..."; "That leaves plenty of room for you to start your new Web business."; "...believes her web business is bound to increase..."; and "the president says web business executives need to understand the uniqueness of their workforce."

Applicant argues that there are several possible interpretations of what the term "WEB BUSINESS" is likely to have when an individual is presented with the mark. While it is possible that there could be different

interpretations or connotations in connection with different goods, we must determine the issue of descriptiveness in connection with the particular products specified in these two applications. When "WEB BUSINESS" is considered in connection with the recordings and publications set forth in the applications, it would be understood to refer to such products which are for and about web businesses. In fact, none of the excerpts made of record by the Examining Attorney is inconsistent with this connotation.

We note that our decision is not affected by any of the third-party registrations made of record by either applicant or the Examining Attorney. None of these registrations involves the goods in question in either of these applications. While these registrations may evidence less than consistent application of the disclaimer rules, they are not determinative of the issues before us in these appeals.

Applicant's other argument that the term sought to be registered is not merely descriptive of the goods specified in the application is not persuasive either. Applicant contends that although the individual words which make up the combination sought to be registered have recognized meanings, the composite, when considered in its entirety,

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is not merely descriptive of the goods specified in the applications. In view of the evidence of record, however, this argument borders on the disingenuous. The combined term "WEB BUSINESS" plainly is commonly used to refer to businesses which conduct their commercial activities using the Internet. The combination of "WEB" and "BUSINESS" does not create any double entendre or unusual, unexpected meaning. The term is frequently used in print, and it identifies both the target market for applicant's goods, web businesses, and the subject matter of applicant's publications and recordings, i.e., topics of interest to web businesses.

For that reason, the refusals to register are affirmed in both appeals.

R. F. Cissel

E. J. Seeherman

C. E. Walters
Administrative Trademark Judges,
Trademark Trial & Appeal Board

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